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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/692,569	10/19/2000	Keiji Watanabe	0941.64850	7511

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EXAMINER	
RESAN, STEVAN A	

ART UNIT	PAPER NUMBER
1773	

DATE MAILED: 02/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/692,569	WATANABE ET AL.	
	Examiner	Art Unit	
	Stevan A. Resan	1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 December 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *16-19,32-40 and 42-49* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *16-19,32-40, and 42-49* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 16 December 2004 has been entered.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 16, 33, 38, 43-46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The limitation of "rate of crosslinking" in claims 16, 33, and 38 is considered new matter. There is no definition of a rate of crosslinking in the specification, only a "bonding ratio %". It is clear that the bonding ratio is more a measure of gel fraction than rate or extent of crosslinking.

Also the end point of the range "85%" in claims 16, 33, and 38 is also new matter having no support in the specification.

Likewise there is no support for the end points of the ranges of claims 43-46

5. Claims 16,18,19,32,35-40,42-49 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Stirniman et al US 6589641.

See Col 4 lines 7-10, 33-34, 41-49; Col 5 lines 15-17; Col 6 lines 6-12, 36-37; Col 7 lines 17-20; Col 8 lines 18-23, 44-46; Col 9 lines 28-32, 38-41.

The claiming of a previously unidentified property that is inherently present does not necessarily make a claim patentable.

It has been held that where claimed and prior art products are identical or substantially identical in structure or in composition, or are produced by identical or substantially identical processes a case of anticipation or a prima facie case of obviousness has been established and the burden of proof is shifted to applicant to show that prior art products do not necessarily or inherently possess the characteristic of a claimed product whether the rejection is based upon "inherency" under 35 USC 102 or on "prima facie obviousness" under 35 USC 103 jointly or alternately. In re Best 562 F2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977); In re Ludke, 58 CCPA 1159,441 F 2d at 212-13, 169 USPQ 563 (1971); In re Brown, 59 CCPA 1036, 459 F. 2d 531, 173 USPQ 685 (1972).

" When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not". In re Spada. 911 F2d 705, 709, 15 USPQ 2d 1655 (Fed. Cir. 1990).

6. Claims 17 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stirniman et al US 6589641 as applied to claims 16 and 33 above in view of Nohr et al US 5747550 for the reasons of record.

7. Claims 16,18,19,32,35-40,42-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stirniman et al US 6589641 in view of Burguette et al US 4705699 for the reasons of record.

8. Claims 17 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stirniman et al US 6589641 in view if Burguette et al US 4705699 as applied to claims 16 and 33 above, and further in view of Nohr et al US 5747550 for the reasons of record.

9. Applicant's arguments filed 16 December 2004 with respect to claims 16-19, 32-40, 42-49 have been fully considered but they are not persuasive.

Applicants argue that the cited references do not disclose or suggest a rate of crosslinking of 85% or more. Applicants assert that "rate of crosslinking" corresponds to "bond ratio". However there is no support in the specification that "rate of crosslinking" corresponds to "bond ratio" only that they are related. A high degree of crosslinking is not required for gelation.

Applicants argue that with Stirniman the dose of energy radiation or duration of exposure must be increased. However, Stirniman appears to use the same energy radiation or duration.

Applicants argue that aStirniman uses the phrase "crosslinked fluoropolymer" but that col 4 line 62 explains that this crosslinking is the one formed between the lubricating layer and the carbon layer. However reading on from Col 4 line 62 to Col 5 line 10 and Col 8 lines 51-52 it is clear that the layer is crosslinked AND bonded. Note that the layer is described as a "solid lubricant layer" which is suggestive of a gelled layer.

Applicants then argue based upon the results of certain application examples and comparative examples. However the showing is not commensurate in scope with the present claims. A specific carbon layer and fluoropolyether compounds are used.

The limited comparative data is hardly commensurate with the extensive class of compounds encompassed by the claims. In re Grasselli 713 F 2d 731, 743, 218 USPQ 769, 778 (Fed Cir 1983).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stevan A. Resan whose telephone number is 571-272-1513. The examiner can normally be reached on Tues-Thurs from 7:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones, can be reached at 571-272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stevan A. Resan
Primary Examiner
Art Unit 1773